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EXAMINER

CARTER, AARON W

ART UNIT PAPER NUMBER

2625

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/722,964

Applicant(s)

UCHIDA, KAORU

Examiner

Aaron W Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-11,15 and 16 is/are rejected.
- 7) ☒ Claim(s) 3-5 and 12-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to papers filed on March 29, 2004.

#### ***Response to Amendment***

2. In response to applicant's amendment received on March 29, 2004, all requested changes to the claims have been entered.

#### ***Response to Arguments***

3. Applicant's arguments filed March 29, 2004 have been fully considered but they are not persuasive.

Applicants argue that Price-Francis is incapable of disclosing or suggesting performing substitute authentication based on other data when authentication based on biometrics results in failure and storing the digital data converted from the biometric data. Applicant goes on to say that Srey does not cure the deficiencies of Price-Francis.

Examiner agrees that Price-Francis does not disclose that when authentication results in failure the biometric data acquired is stored, however Price-Francis does disclose substitute authentication using other biometric data (Fig. 2, wherein the acquisition of fingerprint, at element 66, is compared with stored data, at element 82, and if verification fails, element 110, then the process starts over with acquiring more biometrics and evaluating the substitute biometrics, element 64) as explained in the previous office action, paper number 7. However, Examiner disagrees that Srey does not cure the deficiencies of Price-Francis. As explained in the previous office action in

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regards to claims 2 and 10 Srey teaches a method of increasing security by storing biometric data of a user when an authentication attempt by the user results in failure (column 9, lines 21-37). The combination of Price-Francis and Srey is a proper combination and more explanation is provided below.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 6, 7, 9, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price-Francis (already of record) in view of Srey (already of record).

As to claims 1 and 9, Price-Francis discloses a user authentication method comprising the steps of:

Authenticating a user by verification of biometrics, which is a biological characteristic unique to an individual (Fig. 2);

Acquiring, when the authentication results in failure in the verification of the biometrics, biometrics data of a user who has requested for the authentication; and

Performing substitution authentication based on data other than the biometrics data for substituting the verification of biometrics when the biometrics data are acquired by said acquisition means (Fig. 2, wherein the acquisition of fingerprint, at element 66, is

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compared with stored data, at element 82, and if verification fails, element 110, then the process starts over with acquiring more biometrics and evaluating the substitute biometrics, element 64).

Price-Francis does not disclose expressly that the acquired biometrics data are stored upon failure of verification.

Srey discloses storing biometric data when verification results in failure (column 9, lines 21-38).

Price-Francis & Srey are combinable because they are from the same field of biometric authentication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide the invention of Price-Francis with the teachings of Srey, wherein biometric data of an individual is stored when authentication results in failure.

The suggestion/motivation for doing so would have been that doing so would provide a higher level of security (column 9, lines 21-23).

Therefore, it would have been obvious to combine Price-Francis with Srey to obtain the invention as specified in claims 1 and 9.

As to claims 6 and 15, the combination of Price-Francis and Srey discloses a user authentication apparatus as claimed in claims 1 and 9, Price-Francis further discloses wherein at least a fingerprint is used as the biometrics (Fig. 2).

As to claim 7, the combination of Price-Francis and Srey discloses a user authentication apparatus as claimed in claim 1, Srey further discloses wherein, upon the

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storage of the biometrics data acquired using said sensor, at least an image of an inputting process of a fingerprint is photographed and stored (column 9, lines 21-38).

As to claim 10, the combination of Price-Francis and Srey discloses a user authentication method as claimed in claim 9, Srey further discloses a step of storing the biometrics data acquired by the step of acquiring the biometrics data, and search and pursuit of an illegal user are performed based on the stored biometrics data (column 9, lines 21-38).

6. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price-Francis and Srey as applied to claims 1 and 9 above, and further in view of US Patent 5,799,098 to Ort et al. ("Ort").

As to claims 2 and 11, the combination of Price-Francis and Srey discloses a authentication apparatus of claim 1 and Price-Francis also discloses that false negatives may be the result of poor quality fingerprint images, therefore immediate rejection of the individual may be premature (column 6, lines 59-67)..

The combination of Price-Francis and Srey neglects to explicitly disclose the limitation of determining quality of biometric data and if the quality is not suitable for automatic comparison, then the data is to be stored.

Ort teaches us a process of fingerprint identification and authorization in which a fingerprint image acquired, divided into a plurality of blocks each containing biometric data and the quality of each block is determined. Although the quality is determined to

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be of low quality or unsuitable for automatic comparison, the biometric data is still recorded (Abstract, lines 5-7).

Price-Francis, Srey & Ort are combinable because they are from same field of biometric authentication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide the combination of Price-Francis and Srey with the teachings of Ort.

The suggestion/motivation for doing so would have been that this provides rapid comparison of a fingerprint with those fingerprints of individuals in the repository database (column 6, lines 1-3).

Therefore, it would have been obvious to combine Price-Francis and Srey with Ort to obtain the invention as specified in claims 2 and 11.

7. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price-Francis and Srey as applied to claims 1 and 9 above, and further in view of US Patent 6,430,306 to Slocum et al. ("Slocum").

As to claims 8 and 16, the combination of Price-Francis and Srey discloses a user authentication apparatus as claimed in claims 1 and 9, but neglect to explicitly disclose that upon storage of biometrics data prior to the substitute authentication, at least an image of the face and/or a figure, when a fingerprint is inputted, are photographed. However, Slocum teaches us a process of biometric identification where, as part of an effort to deter individuals from gaining false entry, a photograph of the individuals face is taken and stored for use by law enforcement (column 9, lines 37-45 and column 10, lines

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22-32). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to take the biometric identification that provides a reduction of false negatives as disclosed by the combination Price-Francis and Srey and combined it with the biometric identification technique taught by Slocum, this providing improved systems and methods for maintaining databases that store image information as part of a data record.

*Allowable Subject Matter*

8. Claims 3-5 and 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the



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advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on (703) 308-5246. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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